

**REMARKS**

In the Office Action dated February 28, 2006, the Examiner rejected claims 9-24 under 35 U.S.C. § 101 and rejected claims 1-24 under 35 U.S.C. § 102(b) as being unpatentable over *Millett* (U.S. Patent No. 5,913,209).

By this Amendment, Applicant has amended claims 1-7, 9-15, and 17-23. Based on the following remarks, Applicants respectfully traverse the rejections under 35 U.S.C. §§ 101 and 102.

**I. The Rejections Under 35 U.S.C. § 101**

The Examiner rejects claims 9-16 under 35 U.S.C. § 101 because the phrase "capable of" is "non-limiting language" and thus, according to the Examiner, does not enable these claims to "provide a useful concrete and tangible result." OA at 2. Although Applicant disagrees with the Examiner's position, independent claim 9 has been amended to recite, *inter alia*, "[a]n article of manufacture including instructions for performing, when executed by a processor, operations for matching character sets, wherein the article of manufacture includes a memory device or hardware logic and the operations comprise . . ." Based on at least this amendment, Applicant requests that the rejection of claims 9-16 under 35 U.S.C. § 101 be withdrawn.

The Examiner also rejects claims 17-24 because the claims "are directed towards a system which in light of the specification appears to be software *per se*." OA at 2. Applicant is confused as to the Examiner's basis for this assertion. If the Examiner is asserting the corresponding structure for the means-plus-function language recited in claims 17-24 is limited solely to software program code, the Examiner is incorrect. Claims 17-24 recite a system for matching character sets

including means for performing various functions. As exemplified in Applicant's specification, embodiments consistent with certain aspects of Applicant's invention include a computing environment having computing components that may perform functions consistent with certain embodiments. For example, Fig. 1 shows a computing environment in accordance with certain implementations of the invention having, among other things, a server computer 120 that includes, and interfaces with, components that may perform character set matching processes consistent with the recitations of claims 17-24 . See Specification at ¶¶ [0010] and [0040]. Accordingly, Applicant's specification describes examples of corresponding structure that is not limited solely to a computer program per se, as asserted by the Examiner. Accordingly, the Examiner's rejection of claims 17-24 under 35 U.S.C. § 101 is legally deficient and should be withdrawn.

## II. The Rejections Under 35 U.S.C. § 102(b)

The Examiner asserts *Millett* teaches all of the recitations of claims 1-24. For example, the Examiner asserts *Millett* teaches creating an array of index entries and comparing index entries, including a current and compared index entry, and output files. OA at 3 and 4. Applicant disagrees. *Millett* discloses a system for compressing a text index to recover disk space used by references pointing to deleted documents. *Millett* at 2:45-49. Although *Millett* may mention indexes, counters, documents, and word lists, etc., none of these features show or even suggest at least "creating a set of index entries, where each index entry in the array corresponds to a character set file and stores an index that is also stored in the corresponding character set file, "comparing the indexes stored in the index entries included in the set of index entries to determine

whether any of the index entries match another index entry in the set of index entries," and "updating at least one output file based on the comparing, the at least one output file being configured to store zero or more indexes based on a number of matches between the compared index entries," as recited in amended claims 1, 9, and 17. Indeed, column 15 of *Millett*, cited by the Examiner to reject claim 8, does not show an output file, as recited in Applicant's claims. See OA at 4. Instead, that portion, and any other portion, of *Millett* merely describes how compressed indexes are merged. Indeed, *Millett* states that if a word is in two indexes, the index information of the word is concatenated into a single entry. *Millett* at 15:5-13. Additionally, contrary to the Examiner's assertions, the "overhand" discussion in column 15 in now way teaches output files, as recited in Applicant's claims. See *Millett* at 15:32-40, cited by the Examiner. Instead, *Millett* discloses process for eliminating bit "overhang" problems via a negative jump byte. *Millett* at 15:54-55.

Because the cited art does not teach each and every recitation of independent claims 1, 9, and 17, the cited art does not support the rejection of these claims under 35 U.S.C. § 102(b). Therefore, the rejection is legally deficient, should be withdrawn, and the claims allowed.

Claims 2-8 depend from claim 1. Claims 10-16 depend from claim 9. Claims 18-24 depend from claim 17. As explained, the cited art does not support the rejection of independent claims 1, 9, and 17. As such, the cited art does not support the rejection of dependent claims 2-8, 10-16, and 18-24 for at least the same reasons set forth in connection with the response to the rejection of their corresponding independent claims.

Applicant therefore requests that the rejection of these claims be withdrawn and the claims allowed.

Further, contrary to the Examiner assertions, the cited art fails to teach or suggest the recitations of the above identified dependent claims. For example, the Examiner is incorrect in alleging *Millett* teaches comparing a current index entry to a compared index entry, as recited in claim 2. Instead, *Millett* merely discloses processes for merging indexes associated with updated documents. Moreover, *Millett* fails to teach or suggest selecting another index entry for comparison or replacing current index entry with the compared index entry, based on the comparison of the entries, as recited in claims 3 and 4. Merely concatenating index information into a single entry, as disclosed in column 15 of *Millett*, is not the same as the features recited in claims 3 and 4. As another example, the Examiner is misplaced in asserting *Millett* shows storing an index in the current index entry in an output file associated with a value of a matching counter, as recited in claim 6. Instead, the merge processes (i.e., alpha lists merges, compressed index merges, etc.) disclosed by *Millett* do not represent output files associated with a vale of a matching counter. See *Millett* at 15:47-58. Indeed, nowhere does the reference disclose an association of an output file storing indexes and a counter value.

Accordingly, the cited art does not support the rejection of dependent claims 2-8, 10-16, and 18-24 under 35 U.S.C. § 102(b), and thus the rejection should be withdrawn and the claims allowed.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 26, 2006

By: \_\_\_\_\_

Joseph E. Palys  
Reg. No. 46,508

